

REMARKS

The outstanding Office Action addresses claims 1, 3-15, and 37. Applicants appreciate the Examiner's indication that claims 7-15 represent allowable subject matter and that these claims would be allowed if rewritten in independent form. Applicants continue to submit, however, that all claims represent allowable subject matter, and reconsideration and allowance thereof is respectfully requested.

Amendments to the Claims

Applicants add new claims 38-46. Independent claim 38 corresponds to claims 1 and 7, and claims 39-46 correspond to claims 8-15. Since the Examiner has indicated that claims 7-15 represent allowable subject matter, new claims 38-46 are in condition for allowance and allowance thereof is respectfully requested. No new matter is added.

Rejections Pursuant to 35 U.S.C. §103(a)

While Applicants were successful in overcoming the Examiners' previously rejection, the Examiner now rejects claims 1, 3-6, and 37 pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 406,546 of Taber in view of U.S. Patent No. 5,119,585 of Camp. The Examiner argues that Taber discloses a device having a tissue grasping element with opposed tissue penetrating claws, substantially as claimed, but the Examiner admits that Taber does not disclose a flexible member that is selectively fastenable to a support as required by independent claims 1 and 37. Thus, the Examiner relies on Camp to teach a flexible member attached to a hand tool to prevent accidental dropping of the tool. Applicants respectfully disagree.

The Examiner's assertion that a person having ordinary skill in the art would have been motivated to modify the fishing spear of Taber to include the flexible strap of Camp is misplaced. The Examiner argues that such a combination would have been obvious "to keep the tool attached to the hand of the user to prevent accidental dropping of the tool." (Office Action, page 2.) Taber and Camp, however, are used for different purposes and thus there would be no

motivation to modify Taber's fish spear to include the strap taught by Camp.

Camp discloses a fish handling tool that is used to grasp the lip of a fish *after* the fish has been caught, and to weigh the fish. The tool includes a strap for allowing the fisherman to grip the tool with one hand while holding their fishing rod or line in the other hand. The strap "provides a safety feature to prevent accidental loss of the tool 10 overboard when gripping the fish as it is being landed" (Camp, Col. 4, lines 38-40.) Taber, on the other hand, discloses a fish spear for *catching* fish. The tool is designed to be penetrated into water toward a fish to cause the jaws to close around and penetrate through the fish. The fish spear is not particularly designed for simultaneous use with other tools, as is the handling tool disclosed by Camp, and it is certainly not a handling tool for weighing fish. Accordingly, there is not motivation to prevent dropping of the tool, and thus a person having ordinary skill in the art would *not* have been motivated to modify the fishing spear of Taber to include any type of flexible strap, such as the strap taught by Camp. "[T]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The Examiner has failed to point to any suggestion in either reference to make such a modification.

Taber and *Camp* also cannot be combined to arrive at the present invention because these references represent non-analogous art. In order to rely on a reference in analyzing the obviousness of the subject matter at issue, the reference must be from an analogous field of art. A reference is "analogous" if (1) the reference is within the field of the inventor's endeavor, and if it is not, then (2) the reference must be reasonably pertinent to the particular problem with which the inventor was involved. MPEP 2141.01(a). Neither *Taber* nor *Camp* are within the field of the Applicants' endeavor, and they are not reasonably pertinent to the problem to be solved.

Many medical procedures require organs to be manipulated and maintained at a desired position. In a coronary artery bypass graft (CABG) procedure, for example, manual manipulation and repositioning of the heart is usually necessary to access the blocked arteries.

Devices such as slings and balloons have been developed to help position and/or stabilize the heart. These devices, however, tend to have drawbacks that have hindered their acceptance in the art. For example, slings made of net or fabric tend to interfere with the surgeons access to the surgical target. Moreover, slings require special techniques or procedures to remove the net from the surgical target area. Where a balloon is employed, the heart is freely slidable on the balloon, and not necessarily securely positioned, thus posing a risk of damage during the surgical procedure. Moreover, if a balloon is over-inflated, it can exert excess pressure on the heart, potentially causing damage to the heart. Accordingly, the Applicants of the present invention set out to provide a medical device that allows a body organ to be easily, quickly, and safely grasped in a such a way that does not interfere with the surgeons access to the surgical target area, and to be manipulated and maintained in a desired position.

Neither *Taber* nor *Camp* are in the surgical field of Applicants endeavor, let alone the field of surgical tools, and they are not reasonably pertinent to the problem to be solved. *Taber* relates to a fish spear that is used to catch fish, and *Camp* provides a tool that is used to handle and weigh fish. Fishing tools are certainly not within the field of Applicants' endeavor – fishing tools have no relation to surgical tools.

Moreover, *Taber* and *Camp* address problems fundamentally different from that facing the Applicants in this case. The object of the *Taber* patent is to provide a “fish-spear which shall have a positive and smooth grip, shall be easily set, and which shall be certain in action, besides being adjustable to be used with fishes of various sizes.” (*Taber*, lines 10-14.) The object of the *Camp* patent is to provide “a fish handling tool which provides for easier one hand operation of the jaws which enables a fisherman to utilize the fish handling tool by gripping it with one hand while the fisherman is holding a fishing rod or line in the other” (*Camp*, Col. 1, lines 49-53.) No mention is made in either of these references to provide a medical instrument that can be used to grasp a body organ and to manipulate and maintain the organ in a desired fixed position. An inventor concerned with providing a safe and effective medical device for use in grasping and manipulating a body organ certainly would not look to ways of catching and weighing fish.

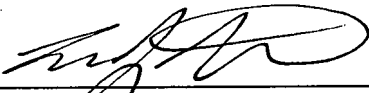
Because *Taber* and *Camp* are in different fields from the present invention, and relate to different problems and solve them in a different way, they cannot be used to support the present rejection. Consequently, it is respectfully maintained that *Taber* and *Camp* are not proper references against the present invention, nor can they be combined in this case.

Conclusion

In view of the remarks above, Applicants submit that all claims are in condition for allowance. Applicants encourage the Examiner to telephone the undersigned in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

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